

REMARKS

By this Amendment, Applicants amend claim 8 to correct a typographical error. Claims 1, 8, and 15 remain pending in this application.

In the Office Action,¹ the Examiner rejected claims 1, 8, and 15 under 35 U.S.C. § 102(e) as being anticipated by Beaton (U.S. Patent No. 6,442,263). Applicants respectfully traverse the rejection for at least the follow reasons.

In order to properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131.

Claim 1 recites a combination including, among other things, a "display mode setting means for setting either a first display mode for displaying only the received message received by said message receiving means or a second display mode for displaying only the user identification information stored in the phone book." Since Beaton does not teach at least this element of claim 1, Beaton does not anticipate the claim.

In the Office Action, the Examiner contends that FIG. 16 of Beaton teaches the above features of claim 1. Applicants respectfully disagree. By contrast, Beaton

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

teaches that “[o]nce a call is transmitted to the receiver’s mobile telephone 210, program 520 searches table 600 for an entry corresponding to the telephone number included in the CLID” (calling line identification). See col. 10, lines 41-44. “If there is a match ..., then program 520 displays the CLID information with the icon associated with the transmitted telephone number from table 600.” See col. 10, lines 44-47. If there is no match in the table 600 ..., then program 520 displays the CLID information with the transmitted icon in display 340.” See col. 10, lines 48-50. Although program 520 displays CLID information with an icon, such a teaching does not constitute the claimed “display mode setting means for setting either a first display mode ... or a second display mode,” as recited in claim 1.

Additionally, as taught by Beaton, a “user may enter ... data using keypad 330” to create a new EBC (electronic business card) (see col. 7, lines 8-11) and may create or modify an icon associated with an EBC (see col. 7, lines 52-58). Beaton also teaches that “while on the phone with the caller, [the user] may select an information icon 1211 to display the EBC associated with the caller.” See col. 8, lines 30-32. If an EBC is not associated with the caller, the user is presented “an option to create a new EBC corresponding to the caller.” See col. 8, lines 36-38. However, these teachings of Beaton also do not constitute Applicants’ claimed “display mode setting means,” which sets “either a first display mode for displaying only the received message received by said message receiving means or a second display mode for displaying only the user identification information stored in the phone book,” as recited in claim 1. Beaton, therefore, does not teach each and every element of claim 1.

For at least the above reasons the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 102(e). Claims 8 and 15, while of a different scope from claim 1 and each other, include recitations similar to those discussed above with respect to claim 1. Accordingly, Beaton also fails to teach elements required by claims 8 and 15 and the Examiner should, therefore, also withdraw the rejection of claims 8 and 15 under 35 U.S.C. § 102(e).

In the Response to Arguments section of the Office Action, the Examiner further contends that claims 1, 8, and 15 recite "intended use limitations" and therefore do not distinguish the claims over the prior art, citing MPEP § 2114. See pages 4-5. Applicants respectfully disagree with the Examiner's contentions. MPEP § 2214 specifies, in relevant part:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

In the *Masham* case, a claim recited a "mixing means," which was "stationary and completely submerged in the developer material." However, the Board held that the amount of submersion is immaterial to the structure of the mixer. The holding in *Masham* is not relevant to the claims of this application since Applicants' claims do not recite a limitation corresponding to the one at issue in *Masham*. For example, as recited in claim 1, the "display mode setting means" specifies limitations that are material to the structure of the display mode setting means such as "displaying only the received message received by said message receiving means" or "displaying only the user identification information stored in the phone book." If the limitations were

different, the operation and structure of the display mode setting means would differ. Furthermore, the limitations that describe Applicants' "display mode setting means" are not analogous to submersion of a mixer into developer material, as was at issue in the *Masham* case. Accordingly, the citation to MPEP § 2214 is improper.

Furthermore, for the Examiner's rejection to stand, the prior art apparatus must teach all structural limitations in order to anticipate a claim. However, in the present Office Action, the Examiner has not demonstrated, for example, that Beaton discloses a "display mode setting means for setting either a first display mode for displaying only the received message received by said message receiving means or a second display mode for displaying only the user identification information stored in the phone book," as recited in claim 1.

Applicants also note that, according to 35 U.S.C. § 112, sixth paragraph, "a claim limitation expressed in means-plus-function language 'shall be construed to cover the corresponding structure described in the specification and equivalents thereof.'" See MPEP § 2181. However, the Examiner may not ignore limitations of a claim simply because they written using means-plus-function language. Instead, the MPEP affirmatively requires the Examiner to address all of the limitations that are recited in the claims. See, e.g., MPEP §§ 2131 and 2143.03. If the Examiner cannot find prior art that meets such requirements, a rejection of the claims cannot stand. Accordingly, for at least the above additional reasons, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 8, and 15 under 35 U.S.C. § 102(e).

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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